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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,996	08/01/2001	Nareak Douk	P563 CIP 2	9126
28390	7590	12/29/2003	EXAMINER	
MEDTRONIC AVE, INC.			NGUYEN, VI X	
3576 UNOCAL PLACE			ART UNIT	
SANTA ROSA, CA 95403			PAPER NUMBER	
			3731	
DATE MAILED: 12/29/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,996

Applicant(s)

DOUK ET AL.

Examiner

Victor X Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 7, 14-18, 23, 28-30, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 19-22, 24-27 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. This application contains claims 7, 14-18, 23, 28-30 and 37-38 drawn to non-elected inventions. In Paper No. 10, dated 12/01/2003, applicant elected to prosecute Species 1 of Figs 3-4. Furthermore, it was stated that claims 1-36 read upon the elected species. It would appear that claims 1-6, 8-13, 19-22, 24-27 and 31-36 relate to Species 1 of Figs 3-4. Claims 7, 14-18, 23, 28-30 and 37-38 are drawn to non-elected Species.

The requirement is still deemed proper and is therefore made **Final**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25, line 2, the use of the word "such as" renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Ex parte Stejewald, 131 USPQ 74.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-13, 19-22, 24-27 and 31-36 are rejected under 35 U.S.C. 102 (b) as being anticipated by Daniel et al (6,001,118).

Daniel et al disclose in figs 19, 20 a-b, col. 1, lines 18-67 and col. 2, lines 1-43, a device (280) for capturing embolic material has all the limitations of claim 1, including: a guide-wire (284); a capture element (290) disposed about the guide-wire. Item 288 is considered a latch that uses to get a hold of the guide-wire.

Regarding claims 2-5, Daniel et al disclose the capture element (290) is fixed to the guide-wire. The device further comprises a stop element (288) disposed on the guide-wire. At least one latch (fig. 19) is positioned between the distal ends of the capture element. The device further comprises an inversion stop (292) fixed to the guide-wire.

Regarding claims 6-9 and 34-36, Daniel et al disclose the device further comprises a hollow, deployment rod (282) disposed about the guide-wire. The deployment rod pushes the capture element along the guide-wire and over the at-least one latch (288) that transforms the capture element from the closed configuration to the deployed configuration. The deployment rod comprises a catheter (figs 19, 20 a-b).

Regarding claims 10-13 and 31, Daniel et al disclose the capture element comprises a filter (290). The capture element comprises a tubular braid of filaments (312). The filaments comprise shape-memory metal wire which is nitinol (see col. 12, lines 7-59).

Regarding claims 19-22, Daniel et al disclose the capture element comprises a support structure (312). The support structure comprises a tubular braid of filaments. The support structure comprises a tube that has been slotted to form struts and the tube comprises nitinol (see fig. 19, col. 11, lines 4-14 and col. 12, lines 6-15).

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Regarding claims 24-27 and 32-33, Daniel et al disclose the capture element comprises a filter that captures the embolic material. The capture element is made of polyurethane material (see col. 11, lines 4-49). The device further has at least one latch (fig. 19) that is suitable for engagement with the capture element and is fixed to the guide-wire (284).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. 5,658,309 to Berthiaume

U.S. Pat. 5,972,019 to Engelson

U.S. Pat. 5,827,324 to Cassell

U.S. Pat. 5,814,064 to Daniel

U.S. Pat. 6,346,116 to Brooks

U.S. Pat. 6,371,971 to Tsugita

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-3982.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

Vn Vn
December 18, 2003



JULIAN W. WOO
PRIMARY EXAMINER